

## REMARKS

Claims 1, 5, 7, 10-24 and 26-31 and 33 are pending. The Examiner has considered claims 1, 5, 7, 10 and 28 which are directed to the elected species. As the Examiner will recall, on June 20, 2008, Applicants filed a Response to an Election of Species Requirement wherein Applicants elected a styrenic polymer for polymer (A1) and a polyamide-series polymer for a polymer (A2).

Claim 1 has been amended to recite that "when an additive is present in the particle, the additive is distributed in the shell or both the core and shell of the particle." Support for this amendment can be found in paragraph [0115] which states that "the additive may be contained in any of the dispersed phase (e.g., each organic solid material constituting the organic solid component (A))."

New claim 33 is essentially identical to claim 1 except that new claim 33 recites that an additive is included in the particle. Support for the various additives can be found in paragraphs [0115]-[0116].

No new matter has been added by way of the above-amendment.

### *Issues Under 35 U.S.C. § 112, First Paragraph*

Claims 1, 5, 7, 10 and 18 are rejected under 35 U.S.C. § 112, first paragraph. Applicants respectfully traverse the rejection.

The Examiner objects to the newly added clause to claim 1 for allegedly adding ***new matter*** to the disclosure. The newly added clause to claim 1 recites that both of the particle and the core thereof are spherical. The Examiner specifically objects to the recitation that the ***core*** is spherical.

In response, Applicants enclose herewith a Declaration under 37 CFR 1.132. The Declaration is being submitted as evidence that it is inherent to the present disclosure that both the particle and the core thereof are spherical.

According to MPEP 2163.07(a):

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.

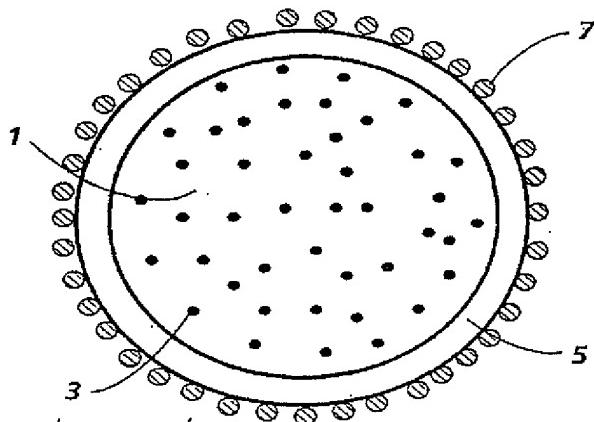
It is clear from the Declaration that the particles formed in all of the Examples of the present specification inherently are shaped such that both the particle and the core thereof are spherical. As such, it is inherent in the disclosure of the present specification that both the particle and the core thereof are spherical and there is written description support in the specification to amend the claims to recite that both the particle and the core thereof are spherical.

Based on the foregoing, withdrawal of the rejection under 35 USC 112, 1<sup>st</sup> paragraph is respectfully requested.

***Issues Under 35 U.S.C. § 102***

Claims 1, 5, 7, 10 and 28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Moffat (U.S. 4,937,167). Applicants respectfully traverse the rejection.

Upon review of Moffat, the Examiner will note that the toner particles of Moffat invariably (i.e., it must) have a colorant. The structure of Moffat's particles is shown in Figure 1 of Moffat which is as follows:



**FIG. 1**

As the Examiner will note, the colorant particles (3) of Moffat are located solely in the core.

This is in contrast to the presently claimed invention. In paragraphs [0115]-[0117] of the present specification, the pigment is listed as being one of many possible "additives" and the additives are distributed in the shell or both the core and the shell of the particle.

As the MPEP directs, all the claim limitations must be taught or suggested by the prior art to establish a *prima facie* case of anticipation. See MPEP § 2131. In view of the fact that Moffat fails to teach or fairly suggest that the colorant is included in the shell or both the core and the shell of the particle, as presently claimed, a *prima facie* case of anticipation cannot be said to exist. As such, withdrawal of the rejection is respectfully requested.

**New claim 33**

Applicants respectfully submit that new claim 33 is further distinguished from the teachings of Moffat. New claim 33 recites types of additives other than the pigments to be included in the particle as disclosed in paragraph 0115-0116. Applicants respectfully submit that new claim 33 does not include a pigment in view of the transitional phrase "consisting of" as

appearing in the last clause which recites: "wherein the particle further comprises an additive which is at least one selected from the group *consisting of* ...".

**Information Disclosure Statement (IDS)**

Applicants note that the Examiner did not initial next to the listing of US 2003-65087 on the PTO SB-08 form which was attached to the April 3, 2007 Office Action. This PTO SB-08 form was timely filed in the May 26, 2006 IDS. Applicants enclose another copy of the PTO SB-08 form which lists US 2003-65087 for the Examiner to initial and sign thereby clarifying for the record that the Examiner has considered US 2003-65087.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq., Registration No. 43,575 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: October 22, 2008

Respectfully submitted,

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Attached:

- 1) Declaration under 37 CFR 1.132
- 2) PTO SB-08 form which lists US 2003-65087